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10/717,800	11/20/2003	Gary M. Klinefelter	F12.12-0127	8584

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EXAMINER	
COLILLA, DANIEL JAMES	
ART UNIT	**PAPER NUMBER**
2854	

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/717,800	KLINEFELTER ET AL.	
	Examiner	Art Unit	
	Daniel J. Colilla	2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 May 2005 and 20 July 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13,15 and 20-49* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13,15,20-41 and 46-49* is/are rejected.

7)☒ Claim(s) *42-45* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *31 May 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *7/20/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 15, 20-21, 24-25, 27, 31, 33, 35, 40 and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Inagaki et al. (US 5,532,724).

With respect to claim 15, Inagaki et al. (US 5,532,724) discloses a method of forming a card including the steps of providing an ink-receptive material with a backing layer 101 and an ink-receptive coating 101a (Inagaki, col. 10, lines 60-62), providing a card member 112 and printing an image on the ink-receptive coating (col. 10, lines 37-44). Figure 18 of Inagaki et al. shows the backing layer 101 being wound onto a reel 103 after it has been removed from the ink-receptive coating 101a. It is noted that applicant has not recited any steps in the body of the claim that are particular to an identification card. Inagaki further discloses laminating the ink-receptive material to a surface of the card member 112 (Inagaki, col. 14, lines 23-27).

With respect to claim 20, Inagaki et al. discloses applying heat with a thermal head 114 during lamination (Inagaki et al., col. 13, lines 16-24). Since the thermal head 114 contacts the card, there must be at least some pressure applied to the card from the head 114.

With respect to claim 21, the ink-receptive material overhangs the edges of the car

member 112 as shown in Figure 18 of Inagaki et al. below the rollers 107b and 107c.

With respect to claim 24, the ink-receptive material is in the form of an ink receptive film 101,101a.

With respect to claim 25, the supply of ink-receptive material 101,101a is an ink-receptive film contained on a supply roll 102.

With respect to claims 27, the card member 112 is a sheet of card substrate material.

With respect to claim 31, Inagaki et al. discloses a device including a supply of ink-receptive material with a backing layer 101 and an ink receptive coating 101a (Inagaki, col. 10, lines 60-62), a laminating section 113,114 configured to laminate the ink-receptive material 101,101a to a surface of a card member 112 as shown in Figure 18 of Inagaki et al. While Inagaki et al. depicts an instance in which a card member is not completely covered in Figure 22, the disclosed device is capable of completely covering the card surface if an image that is desired to be printed also does so.

With respect to claim 33, the ink receptive material 101,101a is an elongated ink-receptive sheet.

With respect to claim 35, the supply of ink-receptive material 101,101a is an ink-receptive film contained on a supply roll 102.

With respect to claim 40, Figure 18 shows a printhead 111 which receives the ink-receptive material for printing on the ink-receptive coating 101a.

With respect to claim 47, as mentioned in claim 15, the ink receptive coating is on the surface of the backing layer.

3. Claims 31-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Ando et al. (JP 9-300675).

With respect to claim 31, Ando et al. discloses a device for forming a card substrate including a supply of ink-receptive material 16,17 which includes a backing layer 16 and an ink-receptive coating 17 as shown in Figure 3 of Ando et al. Further disclosed is a laminating section 9 as shown in Figures 3-6 of Ando et al.

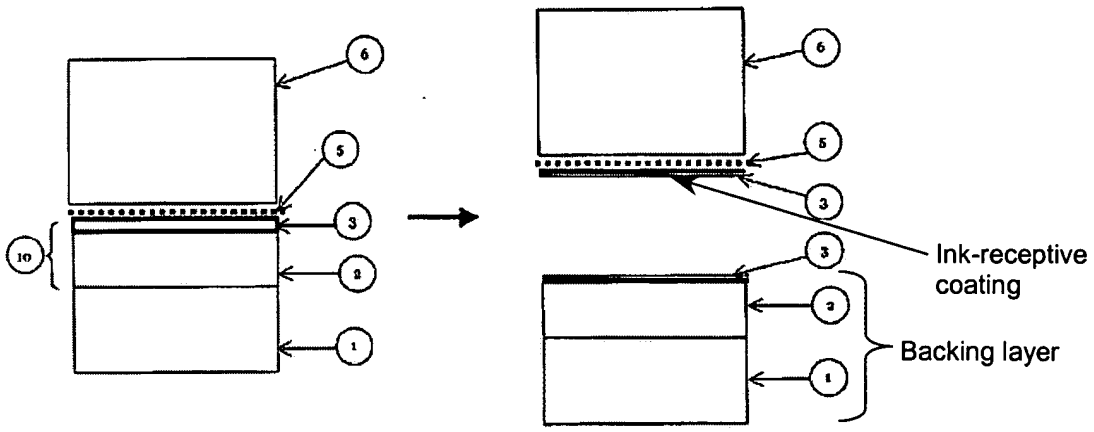
With respect to claim 32, laminating section 9 is a heated roller (see paragraph (0030) of the English translation of Ando et al).

With respect to claim 33, the supply of ink receptive material 16,17 forms one ink-receptive sheet.

4. Claims 1, 4-5, 15 and 22-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Vaidya et al. (US 2002/0012773).

With respect to claim 1, Vaidya et al. discloses a method of forming an ink-receptive card substrate including the steps of providing an ink-receptive material 1,10 including a backing layer (layers 1,2 and a portion of 3) and an ink receptive coating, a portion of layer 3) as shown in Figure 1(C) of Vaidya et al. and in the annotated Figure below taken from Figure 1(C) of Vaidya et al.

FIG. 1 (cont.)
(C)



In paragraph [0065] Vaidya et al. discloses that the final substrate 6 may be a plastic identification card as shown in Figure 1(B). The ink receptive material 1,10 is laminated to the card member 6 as shown in Figure 1(B).

With respect to claims 4 and 22, Vaidya et al. discloses that the ink-receptive material 1,10 is in the form of an individual sheet (paragraph [0023] in reference to carrier substrate 1 which contains receptive layer 10).

With respect to claims 5 and 23, the sheet 1,10 completely covers the surface of the card substrate 6 shown in Figure 1(B) of Vaidya et al.

With respect to claim 15, Vaidya et al. discloses a method of forming an identification card including the steps of providing an ink-receptive material including a backing layer 1 and an ink-receptive coating 10 as shown in Figure 1(A) of Vaidya et al. The coating 10 includes layer 3 which receives ink (in the form of image 5) from a printer (paragraph [0044]). In paragraph [0065] Vaidya et al. discloses that the final substrate 6 may be a plastic identification card as shown in Figure 1(B). The ink receptive material is laminated to the card member 6 as shown in

Figure 1(B) and 1(C).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claim 1-3, 6-9, 13, 46 and 48-49 rejected under 35 U.S.C. 103(a) as being unpatentable over Inagaki et al. (US 5,532,724) in view of Kosaka et al. (2004/0125187).

With respect to claim 1, Inagaki et al. discloses a method of forming an ink-receptive card substrate except for the step of completely covering the surface of the card with an ink receptive coating. Inagaki et al. discloses a method including the steps of providing an ink-receptive material with a backing layer 101and an ink-receptive coating 101a (Inagaki, col. 10, lines 60-62), providing a card member 112 and laminating the ink-receptive material to a surface of the card member 112 (Inagaki, col. 14, lines 23-27). While Inagaki et al. depicts an instance in which a card member is not completely covered in Figure 22, the disclosed device is capable of completely covering the card surface if an image that is desired to be printed also does so. Figure 18 of Inagaki et al. shows the backing layer 101 being wound onto a reel 103 after it has been removed from the ink-receptive coating 101a. Kosaka et al. teaches an ink-receptive layer 92 that is bonded to and completely covers the whole surface of a card (Kosaka et al., paragraph [0139]). It would have been obvious to combine the teaching of Kosaka et al. with the method of forming

an ink-receptive card substrate for the aesthetic advantage of providing an image over the entire surface of a card forming a complete card-shaped picture without any breaks in it.

With respect to claim 2, Inagaki et al. discloses applying heat with a thermal head 114 during lamination (Inagaki et al., col. 13, lines 16-24). Since the thermal head 114 contacts the card, there must be at least some pressure applied to the card from the head 114.

With respect to claim 3, the ink-receptive material overhangs the edges of the car member 112 as shown in Figure 18 of Inagaki et al. below the rollers 107b and 107c.

With respect to claim 6, the ink-receptive material is in the form of an ink receptive film 101,101a.

With respect to claim 7, the supply of ink-receptive material 101,101a is an ink-receptive film contained on a supply roll 102.

With respect to claim 8, Inagaki et al. disclose the claimed method for forming an ink-receptive card substrate except that they do not disclose the dimensions of the card. However, in col. 2, lines 57-62, Inagaki et al. discloses that booklet 5 can be a passport. In Figure 2 of Inagaki et al. the passport is shown next to the card 6. This card is about the size of an identification card. It would have been obvious to make the card a standardized size of an identification card since standards are commonly known information that provide compatibility with other related machines or products.

With respect to claim 9, the card member 112 is a sheet of card substrate material.

With respect to claim 13, Inagaki et al. teaches printing an image on the ink-receptive coating (col. 10, lines 37-44). It is noted that applicant has not recited any steps in the body of

the claim that are particular to an identification card.

With respect to claim 46, as shown in Figure 22 of Inagaki et al. the image is printed with printhead 111 before laminating the ink-receptive material to the surface of the card member.

With respect to claim 48, while Inagaki et al. depicts an instance in which a card member is not completely covered in Figure 22, the disclosed device is capable of completely covering the card surface if an image that is desired to be printed also does so.

With respect to claim 49, as mentioned in claim 15, the ink receptive coating is on the surface of the backing layer. Additionally, while Inagaki et al. depicts an instance in which a card member is not completely covered in Figure 22, the disclosed device is capable of completely covering the card surface if an image that is desired to be printed also does so.

7. Claims 26 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inagaki et al. (US 5,532,724).

With respect to claims 26 and 38, Inagaki et al. disclose the claimed card and method for forming an ink-receptive card substrate except that they do not disclose the dimensions of the card. However, in col. 2, lines 57-62, Inagaki et al. discloses that booklet 5 can be a passport. In Figure 2 of Inagaki et al. the passport is shown next to the card 6. This card is about the size of an identification card. It would have been obvious to make the card a standardized size of an identification card since standards are commonly known information that provide compatibility with other related machines or products.

8. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Inagaki et al. (US 5,532,724), as applied to claims 15, 20-21, 24-25, 27, 31, 33, 35, 40 and 47 above, and further in view of Lyszczarz (US 4,897,533).

Inagaki et al. discloses the claimed method except for the step of cutting an individual card substrate form the a sheet of card substrate material. However, Lyszczarz teaches die-cutting individual cards from a larger sheet of a plurality of cards as shown in Figure 4 of Lyszczarz (col. 4, lines 15-21). It would have been obvious to combine the teaching of Lyszczarz with the method disclosed by Inagaki et al. for the advantage of creating multiple cards in one set of steps rather than repeating separate groups of steps for each individual card.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Inagaki et al. (US 5,532,724) in view of Kosaka et al. (2004/0125187), as applied to claims 1-3, 6-9, 13 and 46-49 above, and further in view of Lyszczarz (US 4,897,533).

Inagaki et al. in view of Kosaka et al. discloses the claimed method except for the step of cutting an individual card substrate form the a sheet of card substrate material. However, Lyszczarz teaches die-cutting individual cards from a larger sheet of a plurality of cards as shown in Figure 4 of Lyszczarz (col. 4, lines 15-21). It would have been obvious to combine the teaching of Lyszczarz with the method disclosed by Inagaki et al. in view of Kosaka et al. for the advantage of creating multiple cards in one set of steps rather than repeating separate groups of steps for each individual card.

10. Claims 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inagaki et al. (US 5,532,724) as applied to claims 15, 20-21, 24-25, 27, 31, 33, 35, 40 and 47 above, and further in view of Conner et al. (2004/0135241).

With respect to claim 29, Inagaki et al. discloses the claimed method of forming an ink-receptive card substrate except for the chip with exposed contacts embedded in the card. However, Conner et al. teaches a card 1 including a chip 6 with exposed contacts 2 as mentioned in paragraph [0022] of Conner et al. It would have been obvious to combine the teaching of Conner et al. with the method of forming an ink-receptive card substrate as disclosed by Inagaki et al. for the advantage of being able to store information about the owner of the card in the card.

With respect to claims 30, Conner et al. discloses in paragraph [0024] that the card is a laminated structure. For the chip in the card to be functional it would require that the contacts be exposed without being laminated over.

11. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inagaki et al. (US 5,532,724) in view of Kosaka et al. (2004/0125187) as applied to claims 1-3, 6-9, 13 and 46-49 above, and further in view of Conner et al. (2004/0135241).

With respect to claim 11, Inagaki et al. discloses the claimed method of forming an ink-receptive card substrate except for the chip with exposed contacts embedded in the card. However, Conner et al. teaches a card 1 including a chip 6 with exposed contacts 2 as mentioned in paragraph [0022] of Conner et al. It would have been obvious to combine the teaching of Conner et al. with the method of forming an ink-receptive card substrate as disclosed by Inagaki

et al. in view of Kosaka et al. for the advantage of being able to store information about the owner of the card in the card.

With respect to claims 12, Conner et al. discloses in paragraph [0024] that the card is a laminated structure. For the chip in the card to be functional it would require that the contacts be exposed without being laminated over.

12. Claims 31, 33, 34, 37, 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashiba et al. (JP 2002307874) in view of Vaidya (US 2002/0012773).

With respect to claim 31, Hashiba et al. discloses the claimed device except for the backing layer of the ink-receptive material. Hashiba et al. discloses a supply 54 of ink-receptive material 55 and a laminating section 57 configured to laminate the ink-receptive material 55 to a surface of a card member 53 as shown in Figure 7 of Hashiba et al. In paragraph [0069] of the English translation Hashiba et al. discloses that the lamination sheet ink-receptive material) has an ink absorbing layer on one side. Vaidya et al. teaches a method of forming a card which includes an ink-receptive material 10 which has an ink absorptive layer 2 and a backing layer 1 as taught in paragraph [0030] of Vaidya et al. It would have been obvious to combine the teaching of Vaidya et al. with the device disclosed by Hashiba et al. for the advantage of the absorptive layer 2 which facilitates drying of the ink (Hashiba et al., paragraph [0033], lines 1-2).

With respect to claim 33, the supply 54 of ink receptive material holds a plurality of sheets 55 as shown in Figure 7 of Hashiba et al.

With respect to claim 34, Hashiba et al. discloses a sheet feed mechanism represented by small circles in Figure 7 of Hashiba et al. which transport individual ink-receptive sheets 55 to

the laminating section 57.

With respect to claim 37, Hashiba et al. discloses a card supply 52 containing a plurality of card members 53 and a feed mechanism configured to transport individual card members to the laminating section as shown by the four small circles to the left of supply 52 in Figure 7 of Hashiba et al.

With respect to claim 39, in paragraph [0004] of the machine translation, Hashiba et al. discloses that the card is a sheet of identification card substrate since the card can have a photograph of a person's face.

With respect to claim 40, Hashiba et al. discloses a printhead 56 that receives an ink-receptive material 55 and prints an image on the coating of the material as shown in Figure 7 of Hashiba et al.

13. Claims 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ando (JP 9-300675).

With respect to claim 35, while it is not known if the embodiment Ando et al. discloses in Figures 1-8 include a supply roll of ink-receptive film, the embodiment shown in Figure 10 of Ando et al. shows an ink receptive film 21 contained on a supply roll below the reference numeral "21" in the Figure. It would have been obvious to combine the teaching of the embodiment shown in Figure 10 of Ando et al. with the embodiment shown in Figures 1-8 of Ando et al. for the advantage of a compact way of storing an elongated film.

With respect to claim 36, Ando et al. discloses a heating roller 9 as shown in Figures 3-6.

14. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Inagaki et al. (US 5,532,724) as applied to claims 15, 20-21, 24-25, 27, 31, 33, 35, 40 and 47 above, and further in view of Vaidya et al. (US 2002/0012773).

Inagaki et al. discloses the claimed device for forming a card substrate except for the printhead being an ink jet printhead. However, Vaidya et al. teaches a method for forming a card substrate using an ink jet printhead (Vaidya et al., see title). It would have been obvious to combine the teaching of Vaidya et al. with the device for forming a card substrate disclosed by Inagaki et al. because ink jet printing provides a flexible and economically attractive option for card printing (Vaidya et al., paragraph (00082).

Allowable Subject Matter

15. Claims 42-45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

16. Applicant's arguments filed 5/31/05 have been fully considered but they are not persuasive of any error in the above rejection.

With respect to applicant's arguments regarding the language, "completely covering" added to claim 1, although Figure 22 does not show it, the device disclosed by Inagaki et al. has the capability to bonding the ink-receptive coating to the complete surface of a substrate. The

coverage is dependent on the image being printed. If an image to be printed is the same size of the card, then the ink receptive material bonded to the card would completely cover the card.

With respect to applicant's arguments regarding that Ando et al. does not disclose a card substrate, it is noted that applicant never positively recites the card as part of the invention. Instead applicant recites that the device is "for forming a card substrate." This is a "for use" statement which indicates how the device is intended to be used but does not positively recite any claim structure. The device disclosed by Ando et al. has the capability to print onto a card.

With respect to applicant's amendment to claim 15, it is noted that only claims 19 and 42-45 had been indicated as allowable if rewritten in independent form, and applicant has not rewritten any of these claims in independent form. It is noted that claim had required that the printing step is performed following the removing step. While applicant may have listed the steps in a desired order in amended claim 15, the actual order that the steps are written in does limit the claim in a chronological manner. Applicant, must positively recite any desired order in which the steps are to be performed. For instance, as applicant recited in original claim 19, "wherein the printing step c) is performed following the removing step" positively recites that the printing step is carried out after the removing step.

With respect to applicant's arguments regarding the Vaidya et al. reference, this reference has been reinterpreted to meet applicant's amended claim language.

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Colilla whose telephone number is 571-272-2157. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 571-272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 29, 2005

Daniel J. Colilla
Primary Examiner
Art Unit 2854